



HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION.

ATTORNEY DOCKET NO. 10007023-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Michael J. BORG
Application No.: 09/991,752
Filing Date: November 26, 2001

Confirmation No.: 3959
Examiner: LIN, Wen Tai
Group Art Unit: 2154

Title: METHOD FOR AUTOMATICALLY COMPLETING AN ELECTRONIC FORM

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on November 20, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

☒ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, Alexandria, VA 22313-1450
Date of Deposit: January 17, 2006

OR

☐ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571) 273-8300.
Date of facsimile:

Typed Name: John S. Reid

Signature: John S. Reid

Respectfully submitted,

Michael J. BORG

By John S. Reid

John S. Reid

Attorney/Agent for Applicant(s)

Reg No. : 36,369

Date : January 17, 2006

Telephone : (509) 534-5789



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450

Date of Deposit: January 17, 2007

Typed Name of Person Mailing Paper or Fee: John S. Reid

Signature: John S. Reid

PATENT APPLICATION
Docket No.: 10007023-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of:

Inventor(s):	Michael J. BORG
Serial No.:	09/991,752
Filed:	November 26, 2001
Title:	METHOD FOR AUTOMATICALLY COMPLETING AN ELECTRONIC FORM
Art Unit:	2154
Examiner:	LIN, Wen Tai
Confirmation No.:	3959

Mail Stop APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

SIR OR MADAM:

This communication is the Reply Brief in this application, which is being filed in response to the Examiner's Answer mailed on November 20, 2006. This Reply Brief is being filed under the provisions of 37 C.F.R. § 41.41.

(Continued on next page.)

1. Real Party In Interest:

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

2. Related Appeals and Interferences:

There are no other appeals or interferences known to the Appellant, the Appellant's legal representative, or assignee which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

3. Status of the Claims:

The following list provides the status of all the claims in the application:
Claims 1-20: rejected – currently on appeal.

4. Status of Amendments:

No amendments to the claims were made, filed or entered after the final action.

5. Summary of Claimed Subject Matter:

The summary corresponds to independent claims 1 and 12, which are the independent claims on appeal. Discussions about elements and recitations can be found at least at the cited locations in the specification and drawings.

Claim 1:

With respect to claim 1, which is the first independent claim on appeal, an automated data entry method comprises entering user information at a first location (330), and then searching a storage medium (340) at said first location to determine an identity of a user based on the entered information (410, 415, 420). The method also includes accessing a storage medium (325) at a second location (320) upon not being able to identify a user by searching the storage medium at said first location (445). The medium at the second location contains information for a plurality of users. The

method also includes searching the storage medium at the second location to determine an identity of said user based on the entered information (450, 455). The method further includes retrieving additional information pertaining to the user from the storage medium at the first or second locations based on the determined identity (425 430, 435, 460). This is to be distinguished from the prior art procedures, wherein a second location is not searched for purposes of determining a user's identity or extracting additional information pertaining to the user. These and other distinctions are further elaborated below. (See specification at page 4, line 22 through page 6, line 18, and Figures 3-4.)

Claim 12:

With respect to claim 12, which is the second independent claim on appeal, a system includes a first website (330) corresponding to a vendor of products or services, the first website having a storage medium (340) containing user information corresponding to a plurality of individuals. The system includes a second website (320) having a storage medium (325) containing user information corresponding to a plurality of individuals. The system also includes a network (300) connecting said first and second websites. The system includes a user station (310) connected to the network, the first website comprises a software application (335) being programmable to communicate with the second website and to search and to retrieve user information from the storage medium at the first and second websites in response to information entered through a user interface of the user station. Also, the software application is further programmed to determine the identity of a user by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of the first and second websites (410-435, 445-460). (See specification at page 5, line 5 through page 6, line 24, and Figures 3-4.)

6. Grounds of Rejection to be Reviewed on Appeal:

(A). Whether claims 1-11 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,199,079 ("Gupta '079"), in view of U.S. Patent No. 5,826,258 ("Gupta '258").

(B). Whether claims 12-20 are unpatentable under 35 U.S.C. § 103(a) over Gupta '079 in view of Gupta '258.

7. Argument:

The Examiner's Position:

The Examiner maintains that claims 1-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,199,079 to Gupta et al. in view of U.S. Patent 5,826,258, also to Gupta et al. The Examiner noted at least in the final action that Gupta '258 is incorporated by reference into Gupta '079. The Examiner states for the first time in the Examiner's Answer that, "the Examiner does not rely on Gupta '079 and Gupta '258 for teaching every detail of the claimed features (otherwise it would have been a 102(b) rejection due to the fact that Gupta '258 was being incorporated by reference into Gupta '079...."

In explaining the rejection of claim 1 (one of the two independent claims), the Examiner specifically alleges that Gupta '079 teaches only a portion of the limitations of claim 1. The Examiner never specifically alleges that the remaining limitations of claim 1 are taught by the prior art.

The only explanation provided by the Examiner for the rejection of claim 12 (the other of the two independent claims), is that, "since the features of [claim 12] can also be found in claims 1-11, [claim 12 is] rejected for the same reasons set forth in the rejection of claims 1-11 above."

The Appellant's Position:

1) The rejections of the claims are procedurally deficient because it has not been made clear to the Appellant exactly what basis and/or what prior art is being relied upon to make the rejections. Until review of the Examiner's Answer, the Appellant understood that the prior art relied upon in making the rejections was limited to Gupta '079 and Gupta '258. The Appellant notes that in making the rejections, the Examiner stated in at least one Office action that, "Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta '079 in view of Gupta '258."

Now, in the Examiner's Answer, the Examiner states, "the Examiner does not rely on Gupta '079 and Gupta '258 for teaching every detail of the claimed features

(otherwise it would have been a 102(b) rejection due to the fact that Gupta '258 was being incorporated by reference into Gupta '079...." (Emphasis added.)

Thus, in view of the apparent conflicting positions expressed by the Examiner, the Appellant, at best, can only guess at specifically what basis and/or prior art the Examiner is relying upon in making the rejections. Accordingly, for at least this reason, it can be concluded that the rejections of the claims are procedurally deficient.

2) The rejections of the claims are procedurally deficient because the Examiner is apparently relying, for the first time in the Examiner's Answer, upon "well known" prior art. Up until the time of Examiner's Answer, the Examiner maintained that, "Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta '079 in view of Gupta '258." Now, apparently for the first time, in the Examiner's Answer, the Examiner states that, "the Examiner does not rely on Gupta '079 and Gupta '258 for teaching every detail of the claimed features (otherwise it would have been a 102(b) rejection due to the fact that Gupta '258 was being incorporated by reference into Gupta '079...." (Emphasis added.)

Thus, while not specifically stated by the Examiner, the Appellant is left to conclude, in view of the fact that no other references are cited, that the Examiner is now (for the first time in the Examiner's Answer) basing the rejections of the claims upon "well known" prior art.

The Examiner may rely upon "well known" prior art as long as: 1) the well known prior art is of such notorious character that official notice can be taken; and 2) the applicant is, during prosecution of the application, given the opportunity to challenge the correctness of such assertions and allegations. (MPEP 2144.03.)

The Appellant has certainly not been given the opportunity during prosecution to challenge the correctness of the Examiner's assertions in regard to "well known" prior art. For what it's worth, the Appellant hereby seasonably challenges the Examiner's use of "well known" prior art, and requests the Examiner provide citations in accordance with the applicable rules and procedures. Furthermore, whatever it is that the Examiner contends is "well known" prior art (which has not been made clear to the Appellant), and which the Examiner is relying upon for rejecting the claims, it is certainly not of such notorious character that official notice can be taken. Accordingly, for at least this reason, the rejections of the claims are procedurally deficient.

3) The rejections are procedurally deficient because the Examiner has not properly established a *prima facie* case. In order to properly establish a *prima facie* case of obviousness, the Examiner must establish that all the claim limitations are taught or suggested by the prior art. (MPEP 2143.03.) Furthermore, all words in a claim must be considered in judging the patentability of that claim against the prior art. (Id. (emphasis added).)

With respect to claim 1, the Examiner has alleged that the prior art discloses only the following elements of that claim: a) entering a user information at a first location; b) searching a storage medium at said first location to determine an identity of a user based on the entered information; and c) retrieving additional information pertaining to the user from the storage medium at the first or second locations based on the determined identity.

The Appellant's claim 1 contains the additional elements of: d) accessing a storage medium at a second location upon not being able to identify a user by searching the storage medium at said first location, said medium at the second location containing information for a plurality of users; and e) searching the storage medium at the second location to determine an identity of said user based on the entered information. The Examiner has not specifically alleged that these additional elements of claim 1 are disclosed by the prior art, and therefore, it can be concluded that the Examiner has not considered all words of the claim, as is required.

With respect to claim 12, the Examiner has not specifically alleged that the prior art discloses any of the elements of that claim. Rather, the only analysis provided by the Examiner in rejecting claim 12 is that, "since the features of [claim 12] can also be found in claims 1-11, [claim 12 is] rejected for the same reasons set forth in the rejection of claims 1-11 above." The elements and/or wording of claim 12 are substantially different than those of claim 1. Therefore, it can be concluded that the Examiner has not considered all words of claim 12, as is required.

For at least these reasons, it can be concluded that the rejections of the claims are procedurally deficient.

4) The rejections are procedurally deficient because the bases of the rejections have not been clearly communicated by the Examiner. The Examiner must properly communicate the basis for a rejection. (MPEP 706.02(j).) Properly communicating the basis for a rejection includes setting forth: a) the difference or differences in the claim

over the applied references; and b) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter. (Id.)

The Examiner goes to great lengths in order to provide excruciatingly detailed explanations of what Gupta '079 and Gupta '258 teach and do not teach. However, much to the bewilderment of the Appellant, the Examiner never clearly indicates the relevance of these detailed explanations, or how these detailed explanations show that the Appellant's claims are obvious. That is, the Examiner never clearly explains the differences in the claims over the applied references, or the proposed modification of the applied references necessary to arrive at the claimed subject matter, as is required.

Instead, the Appellant is left with the impossible task of somehow deciphering the bases for the rejections from the Examiner's detailed explanations of what Gupta discloses and does not disclose. For at least these reasons, it can be concluded that the rejections of the claims are procedurally deficient.

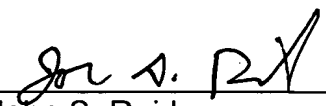
5) The references do not teach or suggest all the claim limitations. Specifically, as the Appellant's Appeal Brief explains in detail, the references do not teach all the limitations of claim 1, nor do the references teach all the limitations of claim 2, as is required for an obviousness rejection.

Summary

The Applicant respectfully considers claims 1-20 to be in condition for allowance, and respectfully requests the Board to overturn the final rejections of those claims, and further requests that those claims be allowed, or in the alternative, to reopen prosecution and to compel the Examiner to clearly delineate the bases for the rejections to the claims.

Dated this 17th day of January, 2007.

Respectfully submitted,
Michael J. Borg (Applicant)



John S. Reid
Attorney and Agent for Appellant
Registration No. 36,369
Telephone: (509) 534-5789

8. Claims Appendix:

Claim 1. An automated data entry method comprising:

entering a user information at a first location;

5 searching a storage medium at said first location to determine an identity of a user based on the entered information;

accessing a storage medium at a second location upon not being able to identify a user by searching the storage medium at said first location, said medium at the second location containing information for a plurality of users;

10 searching the storage medium at the second location to determine an identity of said user based on the entered information; and

retrieving additional information pertaining to the user from the storage medium at the first or second locations based on the determined identity.

15 Claim 2. The method of claim 1 further comprising:

establishing communication from the first location to the second location by a programmable software application at the first location.

20 Claim 3. The method of claim 2 wherein said software application is a browser plug-in module.

Claim 4. The method of claim 1 wherein the first and second locations are connected to a network.

25 Claim 5. The method of claim 4 wherein the network is the Internet.

Claim 6. The method of claim 1 wherein the first and second locations are respectively defined by a first website and a second website.

30 Claim 7. The method of claim 6 wherein said first website is associated with a vendor.

Claim 8. The method of claim 1 wherein the retrieved additional information is presented to the user for verifying accuracy of said information.

Claim 9. The method of claim 8 further comprising the steps of:
verifying an accuracy of said retrieved additional information,
appending the additional information to the entered user information;
transmitting said entered information and said appended additional information;
5 and
processing said transmitted information to complete a transaction.

Claim 10. The method of claim 9 wherein the user selects portions of the additional
information for transmission.

Claim 11. The method of claim 2 wherein the application is further programmable to
search a database associated with the first location.

Claim 12. A system comprising:

15 a first website corresponding to a vendor of products or services, said first
website having a storage medium containing user information corresponding to a
plurality of individuals;

a second website having a storage medium containing user information
corresponding to a plurality of individuals;

20 a network connecting said first and second websites; and

a user station connected to the network, the first website comprising a software
application being programmable to communicate with the second website and to search
and to retrieve user information from the storage medium at the first and second
websites in response to information entered through a user interface of the user station,
25 and wherein the software application is further programmed to determine the identity of
a user by way of matching the information entered through the user interface of the
user station to user information contained on the respective storage mediums of the
first and second websites.

30 Claim 13. The system of claim 12 wherein the network is the Internet.

Claim 14. The system of claim 12, wherein said first website presents a plurality of
products or services offered by a vendor.

Claim 15. The system of claim 14, wherein said first website includes links to additional information pertaining to said products or services.

5 Claim 16. The system of claim 12, wherein said first website facilitates a transaction between the user and the vendor.

Claim 17. The system of claim 12, wherein said first website contains information pertaining to a plurality of users.

10 Claim 18. The system of claim 12, wherein the user selects at least one product or service for purchase from the vendor.

Claim 19. The system of claim 18, wherein a user selection is displayed to the user.

15 Claim 20. The system of claim 19, wherein the user is prompted to enter information for shipping and billing purposes.

-- End of Claims Appendix --

20

(Continued on next page.)

9. Evidence Appendix:

No evidence is submitted in the Evidence Appendix.

10. Related Proceedings Appendix:

5

No evidence is submitted in the Related Proceedings Appendix.